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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,650	01/16/2004	James E. Manuel	016295.1559 (DC-05989)	8070
23640	7590	09/30/2005	EXAMINER	
BAKER BOTTS, LLP			PICKETT, JOHN G	
910 LOUISIANA			ART UNIT	
HOUSTON, TX 77002-4995			PAPER NUMBER	
			3728	
DATE MAILED: 09/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,650

Applicant(s)

MANUEL, JAMES E.

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 15-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment submitted 14 July 2005. Claims 1-6, 8-12, 14-20 are pending in the application. Claims 7 and 13 have been canceled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a breakaway packing system, classified in class 206, subclass 320.
- II. Claims 15-20, drawn to a method of packing a computer system, classified in class 53.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using, such as complete removal of the

Art Unit: 3728

chassis and packing support from the shipping container without leaving the bottom section within the container.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Brian Szymczak on 23 September 2005 a provisional election was made **with traverse** to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

4. Claims 1-3, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Gale (GB 2 246 115 A; previously provided).

Claims 1, 3 and 6: Gale discloses a breakaway packing system with a packing support **14** having a top section **16 & 20**, a bottom section **18 & 20**, and detachable

Art Unit: 3728

joints **25 & 26**. Joints **25 & 26** are dovetail joints and are capable of maintaining their connection while being packed. Further, support **14** is made of a resiliently deformable foam material (page 6, lines 2-4). It is noted that the disclosure of the applicant allows that resilient deformation of the dovetail joint for separation of the top and bottom section is a suitable arrangement (page 18, lines 21-24 of the instant application). As such, resilient deformation is considered "operably designed". Looking at Figure 1, removal of the top section can be accomplished by disconnecting and rotating the top bar **16** and subsequent manual pulling of the assembly. Since the assembly of Gale is made of resiliently deformable foam, the joints **25 & 26** will deform and release their connection. As such, the system of Gale is considered "operably designed" to be detached from the bottom section while the product and bottom sections are still retained in the outer shipping container.

Claim 2: the joint of Gale is reusable.

Claim 5: the claim is a product-by-process claim. However, Gale discloses die cutting (page 3, last paragraph).

5. Claim 4 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gale.

Claim 4 is a product-by-process claim. Gale, as applied to claim 1 above, discloses the claimed product. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

Art Unit: 3728

though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 103

6. Claims 8-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figure 1 of the instant application (hereinafter PA1) in view of Gale.

Claims 8, 10, and 11: PA1 teaches the provision of a computer system 9 within a top-to-bottom support 4 & 6 and shipping container 2. Since the applicant has not challenged the Official Notice taken by the examiner, it is considered admitted that the provision of a printed circuit board, processor, memory, and chassis within a computer system was common and conventional and that their provision within the computer system 9 of PA1 would have been obvious.

PA1 discloses the claimed invention except that PA1 uses a top-to-bottom support that completely surrounds the computer system instead of an end-type support system that only receives a portion of the chassis. Gale shows that an end-type support system that only receives an end of the retained product was an equivalent structure known in the art. Therefore, because these two supports were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the end-type supports of Gale for the top-to-bottom supports of PA1.

Gale discloses a detachable container support 14 designed to receive a fragile item and having a first section 16 & 20, a second section 18 & 20, and detachable joints

Art Unit: 3728

25 & 26. Joints **25 & 26** are dovetail joints and are capable of maintaining their connection while being packed. Further, support **14** is made of a resiliently deformable foam material (page 6, lines 2-4). It is noted that the disclosure of the applicant allows that resilient deformation of the dovetail joint for separation of the top and bottom section is a suitable arrangement (page 18, lines 21-24 of the instant application). As such, resilient deformation is considered “operably designed”. Looking at Figure 1, removal of the top section can be accomplished by disconnecting and rotating the top bar **16** and subsequent manual pulling of the assembly. Since the assembly of Gale is made of resiliently deformable foam, the joints **25 & 26** will deform and release their connection. As such, the system of Gale is considered “operably designed” to be detached from the bottom section while the product and bottom sections are still retained in the outer shipping container.

Claim 9: the joint of Gale is reusable.

Claim 12 is a product-by-process claim. PA1-Gale, as applied to claim 8 above, discloses the claimed product. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim 14 is a product-by-process claim. However, Gale discloses die cutting (page 3, last paragraph).

Response to Arguments

7. Applicant's arguments concerning Morris are persuasive; the rejections based on Morris are hereby withdrawn.

8. Applicant's arguments filed 14 July 2005, with respect to the Gale reference have been fully considered but they are not persuasive. The amendment of the claims to include "operably designed" merely amounts to the provision of functional language. As noted in sections 4 and 6 above, the joints of Gale are resiliently deformable and therefore "operably designed", within the meaning of the term allowed by the applicant. Gale therefore is inherently capable of functioning as claimed. It is therefore maintained that the amendments fail to structurally distinguish over the Gale reference.

9. Applicant's arguments with respect to claims 8-12 and 14 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments with respect to claims 15-20 are moot in view of the newly presented restriction requirement and subsequent provisional election by the applicant.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3728

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

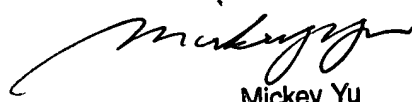
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
23 September 2005


Mickey Yu
Supervisory Patent Examiner
Group 3700